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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86167048
Applicant	Montfort Services Sdn. Bhd.
Applied for Mark	OSKALILY
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Application Serial No. 86167048

For the Mark: OSKALILY

Filed: January 16, 2014

Applicant: Montfort Services Sdn. Bhd.

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**Table of Authorities**

**Cases**

*Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999), *reh'g denied, in banc suggestion declined* (May 25, 1999).

*Chairworks Taiwan, Ltd. v. Bannister*, 13 U.S.P.Q.2d 2070 (M.D.N.C. 1989).

*Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 40 S. Ct. 414, 64 L. Ed. 705 (1920).

*In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (C.C.P.A. 1973).

*In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992).

*Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

*Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

*Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 50 U.S.P.Q.2d 1047 (8<sup>th</sup> Cir. 1999).

*Medi-Flex, Inc. v. Nice-Pak Products, Inc.*, 422 F. Supp. 2d 1242, 82 U.S.P.Q.2d 1722 (D. Kan. 2006).

*Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 U.S.P.Q. 364 (Fed. Cir. 1986).

*Omaha Nat'l Bank v. Citibank (South Dakota), N.A.*, 633 F. Supp. 231, 229 U.S.P.Q. 51 (D. Neb. 1986).

*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

#### Treatises

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4<sup>th</sup> ed. 2015).

TMEP § 1207.01(d)(ii).

Wiley Blevins, “Decoding Multisyllabic Words,” *Scholastic Teacher*,  
<http://www.scholastic.com/teachers/lesson-plan/decoding-multisyllabic-words>.

### **APPLICANT’S APPEAL BRIEF**

#### **I. Introduction**

Pursuant to a timely filed Notice of Appeal, Montfort Services Sdn. Bhd. (“Applicant”) has appealed the decision of the Examining Attorney’s final refusal to register Applicant’s mark OSKALILY (Ser. No. 86167048) (the “Mark”) for various articles of clothing in International Class 25 on the ground that the Mark is likely to be confused with the mark OSKA (Reg. No. 2868680) (the “Cited Registration”), owned by OskaTextilvertriebs GmbH and used in connection with “Women’s and Men’s outer clothing, including of leather, namely, jackets, shirts, suits, pants, dresses, blouses, skirts, belts, Bermuda shorts, sweaters, tops, and sashes; footwear; headwear” in International Class 25.

#### **II. Argument**

The so-called “anti-dissection” rule requires that conflicting marks are to be compared in their entireties, rather than reviewing their individual parts. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920). One must consider the overall commercial impression that a mark would create in the mind of an ordinary prospective purchaser.

It is not necessarily the case that the first syllables or portions of a multi-syllable mark will be dominant. “While some cases indicate that the first word, prefix or syllable in a mark is always the dominant part, it is impossible to make any generalized statement as to whether the beginning or end of a mark is more important when one or the other is used by another seller.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:45 (4<sup>th</sup> ed. 2015) (citations omitted).

With respect to Applicant’s Mark, the dominant portion for the consumer will be the recognizable word “Lily.” A prospective purchaser is far more likely to focus on a familiar word, such as the “Lily” portion of Applicant’s OSKALILY mark, and then wonder how “Oska” modifies the word “Lily.” It is human nature to gravitate to the familiar in an attempt to understand what is being communicated. Consumers will naturally gravitate to the word “Lily” in Applicant’s Mark and will not necessarily view “Oska” as the dominant portion of Applicant’s mark.

Similarly, when learning to read, “decode,” or pronounce multisyllabic words, students are taught to identify the recognizable portion of the designation in question and work from that point. *See, e.g.*, Wiley Blevins, “Decoding Multisyllabic Words,” *Scholastic Teacher*, <http://www.scholastic.com/teachers/lesson-plan/decoding-multisyllabic-words>. This reading habit is inculcated into students and is carried forward throughout adult life. As “Lily” is an easily recognizable word, prospective purchasers are far more likely to see that portion of Applicant’s OSKALILY mark as the dominant element.

In addition, numerous cases have failed to find a likelihood of confusion between marks whose first syllables were similar or identical. The Federal Circuit held in *In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) that the application for the mark VARGA

GIRL for calendars would not be confusingly similar to the registration for the mark VARGAS, also for, *inter alia*, calendars, because, “[w]hen GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.” *See also Omaha Nat’l Bank v. Citibank (South Dakota), N.A.*, 633 F. Supp. 231, 229 U.S.P.Q. 51 (D. Neb. 1986) (no likelihood of confusion as between BANK IN A BILLFOLD and BANK IN A WALLET, both for credit card services); *Chairworks Taiwan, Ltd. v. Bannister*, 13 U.S.P.Q.2d 2070 (M.D.N.C. 1989) (no likelihood of confusion as between CHAIRWORKS and CHAIRMAN, both for chairs); *Medi-Flex, Inc. v. Nice-Pak Products, Inc.*, 422 F. Supp. 2d 1242, 82 U.S.P.Q.2d 1722 (D. Kan. 2006) (preliminary injunction denied as between CHLORAPREP and CHLORASCRUB, both for antimicrobial solution used by medical professionals); *Luigino’s, Inc. v. Stouffer Corp.*, 170 F.3d 827, 50 U.S.P.Q.2d 1047 (8<sup>th</sup> Cir. 1999) (finding no likelihood of confusion between LEAN CUISINE and LEAN ‘N TASTY; “The use of identical, dominant words does not automatically mean that two marks are similar, however.”); *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999), *reh’g denied, en banc suggestion declined* (May 25, 1999) (MAGNIVISION and MAGNA•DOT, both for eyeglass display racks, not likely to be confused); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 U.S.P.Q. 364 (Fed. Cir. 1986) (ROMAN and ROMANBURGER, both for food products). In the instant case, when the “-LILY” portion of Applicant’s Mark is given fair weight, confusion with the registered OSKA mark becomes far less likely.

In addition, a likelihood of confusion analysis must consider “[t]he number and nature of similar marks in use on similar goods” when such evidence is made of record. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of third-party uses of marks that are similar to a cited mark and that are registered or used for similar

goods is relevant to establishing the strength of the cited mark and the scope of protection to which the cited mark is entitled. *See* TMEP § 1207.01(d)(ii) (citing *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)); *see also* *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (TTAB erred by ignoring evidence of third party usage of disputed “Lloyd’s” mark and by rejecting contention, based on such evidence, that the mark was weak and entitled only to narrow range of protection).

In this case, the Cited Registration is for the designation OSKA in stylized lettering (the Cited Registration is not a standard character mark). “Oska” is phonetically similar to the common name “Oscar” and to the designation “Oskar.” Both “Oska” and “Oscar/Oskar” have two syllables, begin with the letters “O-S” and the hard “k” sound, and are followed by a soft “a”. The only difference between “Oska” and “Oscar/Oskar” is the final consonant “r” in “Oscar” or “Oskar,” which is often aspirated rather than pronounced distinctly. In short, “Oska,” “Oscar,” and “Oskar” are so similar in sight, sound, and appearance on their face, that they could be considered likely to be confused.

Nevertheless, the U.S. Patent and Trademark Office has allowed numerous registrations for “Oscar” and “Oskar” marks to coexist with the Cited Registration. Applicant has cited fourteen of these registrations – all in International Class 25 – in its Response to Office Action dated August 11, 2014, and has previously made these registrations of record.

Applicant respectfully suggests that the Examining Attorney erred by not considering the phonetically similar “Oscar” and “Oskar” registrations cited by Applicant. “Marks may sound the same to the ear, even though they may be readily distinguishable to the eye.” *McCarthy on Trademarks and Unfair Competition* § 23:22.

Given the evidence of the common use of the phonetically similar and visually similar word “Oscar” or “Oskar” in connection with clothing in Class 25, the Cited Registration should be afforded a relatively narrow scope of protection. If “Oska,” “Oscar,” and “Oskar” marks can coexist on the Principal Register in International Class 25, then surely the Cited Registration will not be confusingly similar to Applicant’s Mark, especially when one considers the Mark (OSKALILY) as a whole.

Viewing the Mark in its entirety, confusion among consumers is unlikely with respect to the Cited Registration. The only common element between Applicant’s Mark and the Cited Registration is the “Oska” portion of the marks. In light of the crowded field of marks for the visually and phonetically similar “Oscar” and “Oskar” marks in Class 25, the distinctions between Applicant’s Mark and the Cited Registration should be given greater weight in analyzing the similarity of the marks. *See, e.g., Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

The appearances of Applicant’s Mark and the Cited Registration are materially different. The “-LILY” portion of Applicant’s Mark provides a very different appearance and sound than the Cited Registration. Applicant’s Mark is a four-syllable designation while the Cited Registration has only two syllables. While Applicant’s Mark ends with the pleasant, poetic “LILY” sound, the Cited Registration ends with a hard “KA” sound.

In addition, the two marks have dissimilar connotations. The “-LILY” portion of Applicant’s Mark lends a connotation of flowers, femininity, freshness, and nature that is entirely devoid from the Cited Registration. In contrast, the Cited Registration has a rather harsh sound reminiscent of a Germanic or Slavic word, which is reinforced by the hard “K” sound and the

final vowel sound of a soft “a”. The Cited Registration has a definite hard, male connotation which is very different from the soft, feminine OSKALILY mark.

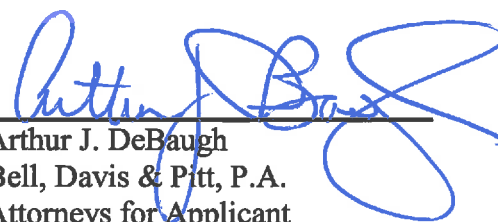
In short, with respect to the source-indicating features of the Applicant’s Mark and the Cited Registration, the marks are dissimilar in appearance, dissimilar in sound, and dissimilar in overall commercial impression. Consumers are therefore unlikely to confuse Applicant’s Mark with the Cited Registration.

### **III. Conclusion**

Applicant respectfully submits that there is no likelihood of confusion between the Mark and the Cited Registration. Due to numerous third-party registrations of phonetically similar marks, the evidence suggests that the Cited Registration is entitled to a relatively narrow scope of protection and that consumers would be unlikely to believe that Applicant’s goods and the goods of the Cited Registration come from the same source, especially given the overall dissimilarity of the marks when compared in their entireties.

Montfort Services Sdn. Bhd.

Dated: November 23, 2015

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